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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/346,910	11/30/1994	STUART A LIPTON	00108017004	3596

7590

03/25/2002

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EXAMINER

GUCKER, STEPHEN

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 03/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/346,910

Applicant(s)

Lipton

Examiner

Stephen Buckle

Group Art Unit

1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE TWO MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/10/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 2-8, 11, 12, & 14 is/are pending in the application.
- ☐ Of the above claim(s) 2-7 is/are withdrawn from consideration.
- ☒ Claim(s) 8, 11, & 12 is/are allowed.
- ☒ Claim(s) 14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1647

*Response to Amendment*

1. Receipt of the Appeal Brief, Paper No. 29, filed 1/10/02, is acknowledged.

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2. The Examiner has noted that the Appeal Brief is defective because:

The brief does not contain a concise explanation of the invention defined in the claim involved in the appeal, which refers to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(5).

Under Appellant's "(5) Summary of Invention" section of the brief, there is no reference to the specification by page and line number that is required by 37 CFR 1.192(c)(5).

3. The finality of the previous Office Action is being withdrawn in order to make a requirement for information under 37 CFR 1.105.

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4. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

(1) The nucleotide sequence of deposited clone ATTC 97525.

Because no nucleotide sequence information is taught by the specification, a reasonable and meaningful search for every fragment of nucleic acid comprising at least 20 contiguous bases of clone ATCC 97525 wherein said nucleic acid is able to selectively hybridize to nucleic acid encoding human MEF2C (as recited in claim 14) cannot be made because there is no information available about the particular nucleotide sequence of clone ATTC 97525 that would enable the examiner to search nucleotide databases for either prior art or enablement or written description

Art Unit: 1647

considerations. Applicant has made of record the statement, "the specification, including deposited clone 97525, provides a written disclosure of the chemical entities claimed. Each and every nucleic acid consisting of at least 20 contiguous nucleotides of the disclosed clone can be determined by this disclosure; thus isolated nucleic acids comprising such structures can be readily identified." (Appeal Brief, page 5, lines 7-10, Paper No. 29, filed 1/10/02). Since applicant is on record as asserting that each and every nucleic acid consisting of at least 20 contiguous nucleotides can be determined by the disclosure, this request cannot be considered as unduly burdensome to applicant.

5. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

6. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

Art Unit: 1647

7. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of TWO months. EXTENSIONS OF THIS TIME PERIOD MAY BE

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GRANTED UNDER 37 CFR 1.136(a).

8. Claims 8 and 11-12 are in condition for allowance.

9. Claim 14 remains rejected for all reasons of record.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SG

Stephen Gucker

March 19, 2002

*Gary L. Kunz*  
GARY L. KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600